IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: §   Filed: June 22, 2001

     Cary L. Bates et al.   §

                             §   Group Art Unit: 3622

Serial No.:   09/887,621   §

                             §   Examiner: Michael Bekerman

Confirmation No.:   7429   §

For: ENCOURAGING HOUSE CARD USE THROUGH PRICE GUARANTEES

MAIL STOP APPEAL BRIEF - PATENTS
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October 5, 2010   /C. Alexandra Livingston/   Date   C. Alexandra Livingston

Dear Sir:

APPEAL BRIEF

Applicants submit this Appeal Brief to the Board of Patent Appeals and Interferences on appeal from the decision of the Examiner of Group Art Unit 3622 dated May 5, 2010, finally rejecting claims 1-18, 20-22 and 24-30. The final rejection of claims 1-18, 20-22 and 24-30 is appealed. This Appeal Brief is believed to be timely since it is transmitted by the due date of October 5, 2010, as set by the filing of a Notice of Appeal on August 5, 2010.

Since an appeal brief fee in the amount of $500 has been paid for a previous appeal that did not reach a Board Decision, the fees due for filing this appeal brief is the difference between the current fee of $540 and the previously paid amount of $500. The Commissioner is hereby authorized to charge $40 to counsel's Deposit Account No. 09-0465 / ROC920010071US1 for filing this appeal brief, and for any other fees required to make this appeal brief timely and acceptable to the Office.

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Real Party in Interest

  The present application has been assigned to International Business Machines Corporation, Armonk, New York.

Related Appeals and Interferences

Applicant asserts that no other appeals or interferences are known to the Applicant, the Applicant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

Status of Claims

Claims 1-18, 20-22 and 24-30 are pending in the application. Claims 1-28 were originally presented in the application. Claims 29 and 30 have been added during prosecution. Claims 19 and 23 have been canceled without prejudice. Claims 1-18, 20-22 and 24-30 stand finally rejected as discussed below. The final rejections of claims 1-18, 20-22 and 24-30 are appealed. The pending claims are shown in the attached Claims Appendix.

Status of Amendments

All claim amendments have been entered by the Examiner, including amendments to the claims proposed after the final rejection.

Summary of Claimed Subject Matter

A.   CLAIM 1 – INDEPENDENT

One embodiment of the invention provides a method for price-guaranteeing an item purchased by a customer. Page 3, Li. 17-18. The method includes determining, by operation of one or more computer processors, whether the item is purchased using a store credit card account for the store from which the item is purchased. Page 12, Li. 22-24; Figure 7, step 730. The method further includes, if the item is purchased using the store credit card account, receiving, by a central computer system, transaction data from a cash register computer system, the transaction data including an item identification number and an item purchase price. Page 12, Li. 27-31; Figure 7, steps 735 and 740. Additionally, the method includes comparing the item purchase price to a comparison price comprising at least one of an item current price and an item match price. Page 13, Li. 30-32; Page 14, Li. 1-2; Figure 8, step 835. Furthermore, the method includes, if the item purchase price is higher than the comparison price, crediting an amount to the store credit card account of the customer. Page 15, Li. 26-33; Page 16, Li. 1-2; Figure 10, steps 1040 and 1045. Finally, the method includes, if the item is not purchased using the store credit card account, notifying the customer of potential credits obtainable if the store credit card had been used. Page 16, Li. 7-10.

B.   CLAIM 13 - INDEPENDENT

Another embodiment of the invention provides a computer readable storage medium, including a program which, when executed by a processor, performs operations for price-guaranteeing an item purchased by a customer. Page 3, Li. 24-26. The operations include determining whether the item is purchased using a store credit card account for the store from which the item is purchased. Page 12, Li. 22-24; Figure 7, step 730. The operations further include, if the item is purchased using the store credit card account, receiving, by a central computer system, transaction data from a cash register computer system, the transaction data including an item identification number and an item purchase price. Page 12, Li. 27-31; Figure 7, steps 735 and 740.

Additionally, the operations include comparing the item purchase price to a comparison price comprising at least one of an item current price and an item match price. Page 13, Li. 30-32; Page 14, Li. 1-2; Figure 8, step 835. Furthermore, the operations include if the item purchase price is higher than the comparison price, crediting an amount to the store credit card account of the customer. Page 15, Li. 26-33; Page 16, Li. 1-2; Figure 10, steps 1040 and 1045. Finally, the operations include if the item is not purchased using the store credit card account, notifying the customer of potential credits obtainable if the store credit card had been used. Page 16, Li. 7-10.

C.   CLAIM 22 - INDEPENDENT

Yet another embodiment of the invention provides an apparatus for price-guaranteeing an item purchased by a customer. Page 4, Li. 3-4. The apparatus includes a central computer system having a processor, a memory and one or more storage devices for storing data connected to the processor. Page 4, Li. 4-6. The processor is configured to determine whether the item is purchased using a store credit card account for the store from which the item is purchased. Page 12, Li. 22-24; Figure 7, step 730. Additionally, the processor is configured to, if the item is purchased using the store credit card account, receive transaction data from a cash register computer system, the transaction data including an item identification number and an item purchase price. Page 12, Li. 27-31; Figure 7, steps 735 and 740. Furthermore, the processor is configured to compare the item purchase price to a comparison price comprising at least one of an item current price and an item match price. Page 13, Li. 30-32; Page 14, Li. 1-2; Figure 8, step 835. The processor is also configured to, if the item purchase price is higher than the comparison price, credit an amount to a store credit card account of the customer. Page 15, Li. 26-33; Page 16, Li. 1-2; Figure 10, steps 1040 and 1045. The processor is further configured to, if the item is not purchased using the store credit card account, notify the customer of potential credits obtainable if the store credit card had been used. Page 16, Li. 7-10.

Grounds of Rejection to be Reviewed on Appeal

1.   Rejection of claims 1-11, 13-18, 20-22, and 23-28 under 35 U.S.C. 103(a) as being unpatentable over *McClung* (U.S. Pub No. 2004/0143502).

2.   Rejection of claims 11, 12, 29, and 30 under 35 U.S.C. 103(a) as being unpatentable over *McClung* (U.S. Pub No. 2004/0143502) in view of *Walker* (U.S. Pub No. 2001/0042785).

ARGUMENTS

1.   Rejection of claims 1-11, 13-18, 20-22, and 23-28 under 35 U.S.C. § 103(a) as being unpatentable over *McClung*.

The Applicable Law

The Examiner bears the initial burden of establishing a prima facie case of obviousness. See MPEP § 2141. Establishing a prima facie case of obviousness begins with first resolving the factual inquiries of Graham v. John Deere Co. 383 U.S. 1 (1966). The factual inquiries are as follows:

(A) determining the scope and content of the prior art;

(B) ascertaining the differences between the claimed invention and the prior art;

(C) resolving the level of ordinary skill in the art; and

(D) considering any objective indicia of nonobviousness.

Once the Graham factual inquiries are resolved, the Examiner must determine whether the claimed invention would have been obvious to one of ordinary skill in the art.

The References

McClung is directed to a computer-implemented method for guaranteeing a consumer a best price on an item or service purchased from a vendor for a predetermined time period following the transaction. (Abstract, *McClung*). The method disclosed by *McClung* monitors prices after a purchase by a consumer and if a lower price is found at a later time, gives a consumer a refund, a credit, and/or a coupon or certificate for use equaling the difference in sale prices. (See, e.g., ¶[0007], ¶[0150], Figures 5 and 11, *McClung*).

The Examiner's Argument

The Examiner argues that:

McClung teaches a host computer system as tracking a transaction by the item and purchase price, receiving and storing price matching data including an item match price, comparing the purchase price to a comparison price (item match price) periodically (over different time periods), and administering a credit for the price differential to the customer if the comparison price is lower than the purchase price (Paragraph 0007). The system would inherently have to obtain an account number (customer identification number) in order to credit the customer's account. McClung also teaches the credit card account as being an account with the vendor (Paragraph 0008, Sentence 3 and Paragraph 0131, Sentence 1). A step of determining whether a user is a member of the system (signed up through a vendor) is inherent when a purchase takes place. McClung, however, does not specify what action takes place should a user not have an account with the system. It would have been obvious to one having ordinary skill in the art at the time the invention was made to notify a non-member at a time of purchase as to an explanation of the types of savings (such as price matching or price guarantees) that could be incurred through signing up. This would provide a greater chance of that non-member signing up.

Applicants' Response to the Examiner's Argument

Applicants respectfully submit that *McClung* does not teach or suggest all the claim limitations. For example, *McClung* does not teach or suggest determining whether the item is purchased using a store credit card account for the store from which the item is purchased. The Examiner argues that "[a] step of determining whether a user is using a vendor credit card (and therefore, signed up through a vendor) is inherent when a purchase takes place via credit card (regular Visa versus a store card, and vice versa)." Respectfully, the Examiner errs.

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

Applicants respectfully submit that a payment acceptance system such as that disclosed in the *McClung* reference may receive information as to the method of payment for a <u>purchase transaction</u>, but may not necessarily "determine" whether a specific "item" was purchased with a using a store credit card account. Rather, such a system may receive a payment amount and payment information, but may not have any way of knowing store-specific information such as the specific items being purchased. For example, suppose that a consumer purchased multiple items in one transaction but provides partial payment in cash and partial payment via credit card. The system would recognize the total purchase price for the entire transaction, and may recognize that the transaction as a whole has been completely paid for, but would not distinguish as to which items in the transaction were paid for by cash and which items were paid for by credit card. In other words, the type of payment is only linked to the transaction as a whole and not to the individual items purchased. Thus, a system such as that taught in *McClung* would not necessarily include information as to whether an item is purchased using a store credit card account. Therefore, the inherency relied upon by the Examiner is flawed.

As another example, *McClung* does not teach or suggest that different actions are performed <u>based</u> upon the determination of whether the item is purchased using a store credit card account for the store from which the item is purchased. As recited in the claims, price guarantee credits are given only for items purchased using a store credit card account, whereas, for items <u>not</u> purchased using a store credit card account, a notification is given to the customer about the potential credits obtainable if the store credit card had been used. In other words, the claims recite performing different actions based on whether a store credit card account is used to purchase the item. *McClung* teaches no such distinction, and to this end the Examiner admits that *McClung* "does not specify what action takes place should a user not have an account with the system." While such a characterization is appropriate, Applicants respectfully submit that the reason McClung does not specify what action should take place when the user does not have an account with the system is because, at a fundamental level, *McClung* does not teach or suggest <u>different</u> actions being performed based on the determination of

whether an item is purchased using a store credit card account. As such, Applicants respectfully submit that the inherency relied upon by the Examiner is flawed.

As yet another example, *McClung* does not teach or suggest notifying the customer of potential credits obtainable if the store credit card had been used, if the item is not purchased using the store credit card account. The Examiner argues that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to notify a non-member at a time of purchase as to an explanation of the types of savings (such as price matching or price guarantees) that could be incurred through signing up. This would provide a greater chance of that non-member signing up." Applicants respectfully submit that the Examiner has mischaracterized the teachings of the cited reference and has applied improper hindsight in stating that such feature would have been obvious. *McClung* does not teach or suggest any different treatment between customers who used store credit cards to make a purchase and those who did not, since *McClung* discloses providing price guarantees to customers without distinguishing treatments between customers who have store credit cards and those who do not. Therefore, there is no teaching or suggestion by *McClung* for notifying customers of the potential credits.

The other pending independent claims are rejected pursuant to the same rationale as was claim 1 and, accordingly, are believed to be allowable for the same reasons given above. Since Applicants believe that the independent claims are allowable, the dependents are therefore also believed to be allowable.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

2.   Rejection of claims 11, 12, 29, and 30 under 35 U.S.C. 103(a) as being unpatentable over *McClung* in view of *Walker*.

The References

McClung is discussed above. *Walker* discloses a financial tender system which allows a transferor to transfer credit or make payment to a transferee by debiting the

credit card of the transferor and crediting the credit card of the transferee. (Abstract, *Walker*).

The Examiner's Argument

Regarding claims 11, 12, 29 and 30, the Examiner argues that

McClung teaches crediting an account with a vendor to implement a guaranteed pricing promotion. McClung doesn't teach the transferring of balances between different credit accounts. Walker teaches that it is well-known to transfer debt balances between accounts to take advantage of different account features (Paragraph 0011, Sentence 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to transfer a credit balance from one account to another in order to take advantage of retailer guaranteed pricing. It would also have been obvious to one having ordinary skill in the art at the time the invention was made to notify a non-member at a time of purchase as to potential credits that could be incurred through transferring a balance. This would provide a greater chance of that non-member transferring the balance.

Applicants' Response to the Examiner's Argument

Applicants respectfully submit that *McClung*, as discussed in the above examples, fails to teach or suggest all of the claim limitations with respect to the independent claims. Moreover, the cited references, *McClung* and *Walker*, either alone or in combination, fail to teach or suggest notifying the customer of potential credits if the item is not purchased using the store credit card account. Furthermore, the cited references, neither alone nor in combination, fail to teach or suggest determining whether the customer has transferred a balance from another credit card account to the store credit card account, wherein the amount is credited to the store credit card account of the customer if the customer has transferred a balance from another credit card account to the store credit card account. Applicants respectfully submit that the Examiner again has applied improper hindsight in stating that such feature would be obvious. The cited references simply do not provide any teaching or suggestion for any incentive for transferring balances.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

CONCLUSION

The Examiner errs in finding that:

1.   Claims 1-12 are directed towards nonstatutory subject matter;

2.   Claims 1-11, 13-18, 20-22, and 23-28 are unpatentable over *McClung*; and

3.   Claims 11, 12, 29, and 30 are unpatentable over *McClung* in view of *Walker*.

Withdrawal of the rejections and allowance of all claims is respectfully requested.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

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CLAIMS APPENDIX

1.   (Previously Presented)   A method for price-guaranteeing an item purchased by a customer, comprising:

determining, by operation of one or more computer processors, whether the item is purchased using a store credit card account for the store from which the item is purchased;

if the item is purchased using the store credit card account:

receiving, by a central computer system, transaction data from a cash register computer system, the transaction data including an item identification number and an item purchase price;

comparing the item purchase price to a comparison price comprising at least one of an item current price and an item match price; and

if the item purchase price is higher than the comparison price, crediting an amount to the store credit card account of the customer; and

if the item is not purchased using the store credit card account, notifying the customer of potential credits obtainable if the store credit card had been used.

2.   (Previously Presented)   The method of claim 1, wherein the store credit card account is a department store credit card account.

3.   (Original)   The method of claim 1, wherein the amount represents a price differential between the item purchase price and the comparison price.

4.   (Original)   The method of claim 1, wherein the transaction data includes one or more information selected from a customer identification number, an item description, a quantity of item purchased and a purchased date.

5.   (Original)   The method of claim 1, wherein the step of comparing is periodically performed.

6.   (Original)   The method of claim 1, further comprising:

receiving, by the central computer system, price matching data from the cash register computer system, the price matching data including at least one of an item identification number, the item match price, an item sale start date, an item sale duration, and a competitor store identification; and

storing price matching data into a data storage device of the central computer system.

7.   (Previously Presented)   The method of claim 1, further comprising:

providing an explanation for crediting the credit card account of the customer, wherein the explanation is selected from one of:

a price guarantee credit for a price reduction from the same department store;

a price match credit for matching a price from another store; and

an error.

8.   (Original)   The method of claim 1, wherein the transaction data further includes an item purchase date.

9.   (Previously Presented)   The method of claim 8, further comprising:

comparing the item purchase date to a current date;

if the item purchase date is the same as the current date, comparing the item purchase price to the item current price to determine whether an error occurred; and

if the error occurred, crediting a price differential to the credit card account of the customer.

10.   (Original)   The method of claim 8, further comprising:

comparing the item purchase date to a current date; and

crediting the amount only if the current date is within a price-guarantee period from the item purchase date.

11. (Previously Presented)   The method of claim 1, further comprising:

if the item is not purchased using the store credit card account, notifying the customer of potential credits if a balance is transferred from another credit card account to the store credit card.

12. (Previously Presented)   The method of claim 11, further comprising:

determining whether the customer has transferred a balance from another credit card account to the store credit card account, wherein the amount is credited to the store credit card account of the customer if the customer has transferred a balance from another credit card account to the store credit card account.

13. (Previously Presented)   A computer readable storage medium, comprising a program which, when executed by a processor, performs operations for price-guaranteeing an item purchased by a customer, the operations comprising:

determining whether the item is purchased using a store credit card account for the store from which the item is purchased;

if the item is purchased using the store credit card account:

receiving, by a central computer system, transaction data from a cash register computer system, the transaction data including an item identification number and an item purchase price;

comparing the item purchase price to a comparison price comprising at least one of an item current price and an item match price; and

if the item purchase price is higher than the comparison price, crediting an amount to the store credit card account of the customer; and

if the item is not purchased using the store credit card account, notifying the customer of potential credits obtainable if the store credit card had been used.

14. (Previously Presented)   The computer readable storage medium of claim 13, wherein the amount represents a price differential between the item purchase price and the comparison price.

15.　(Previously Presented)　The computer readable storage medium of claim 13, wherein the transaction data includes one or more information selected from a customer identification number, an item description, a quantity of item purchased and a purchased date.

16.　(Previously Presented)　The computer readable medium of claim 13, wherein the step of comparing is periodically performed.

17.　(Previously Presented)　The computer readable storage medium of claim 13, wherein the operations further comprise providing an explanation for crediting the credit card account of the customer, wherein the explanation is selected from one of:

a price guarantee credit for a price reduction from the same department store;

a price match credit for matching a price from another store; and

an error.

18.　(Previously Presented)　The computer readable storage medium of claim 13, wherein the operations further comprise:

receiving, by the central computer system, price matching data from the cash register computer system, the price matching data including at least one of an item identification number, the item match price, an item sale start date, an item sale duration, and a competitor store identification; and

storing price matching data into a data storage device of the central computer system.

19.　(Cancelled)

20.　(Previously Presented)　The computer readable storage medium of claim 13, wherein the transaction data further includes an item purchase date, and wherein the operations further comprise:

comparing the item purchase date to a current date;

if the item purchase date is the same as the current date, comparing the item purchase price to the item current price to determine whether an error occurred; and

if an error occurred, crediting a price differential to the credit card account of the customer.

21.   (Previously Presented)   The computer readable storage medium of claim 13, wherein the transaction data further includes an item purchase date, and wherein the operations further comprise:

comparing the item purchase date to a current date; and

crediting the amount only if the current date is within a price-guarantee period from the item purchase date.

22.   (Previously Presented)   An   apparatus   for   price-guaranteeing   an   item purchased by a customer, comprising:

a central computer system having a processor, a memory and one or more storage devices for storing data connected to the processor, wherein the processor is configured to:

determine whether the item is purchased using a store credit card account for the store from which the item is purchased;

if the item is purchased using the store credit card account:

receive transaction data from a cash register computer system, the transaction data including an item identification number and an item purchase price;

compare the item purchase price to a comparison price comprising at least one of an item current price and an item match price; and

if the item purchase price is higher than the comparison price, credit an amount to a store credit card account of the customer; and

if the item is not purchased using the store credit card account, notify the customer of potential credits obtainable if the store credit card had been used.

23.   (Cancelled)

24.   (Original)   The apparatus of claim 22, wherein the processor is further configured to periodically compare the item purchase price to the comparison price.

25.   (Original)   The apparatus of claim 22, wherein the processor is further configured to:

receive price matching data from the cash register computer system, the price matching data including one or more information selected from an item identification number, the item match price, an item sale start date, an item sale duration, and a competitor store identification; and

store price matching data into a data storage device of the central computer system.

26.   (Previously Presented)   The apparatus of claim 22, wherein the processor is further configured to provide an explanation for crediting the credit card account of the customer, wherein the explanation is selected from one of:

a price guarantee credit for a price reduction from the same department store;

a price match credit for matching a price from another store; and

an error.

27.   (Previously Presented)   The apparatus of claim 22, wherein the processor is further configured to

receive transaction data including an item purchase date;

compare the item purchase date to a current date;

if the item purchase date is the same as the current date, compare the item purchase price to the item current price to determine whether an error occurred; and

if an error occurred, credit a price differential to the credit card account of the customer.

28. (Original)   The apparatus of claim 22, wherein the processor is further configured to:

receive transaction data including an item purchase date;

compare the item purchase date to a current date; and

credit the amount only if the current date is within a price-guarantee period from the item purchase date.

29. (Previously Presented)   The apparatus of claim 22, wherein the processor is further configured to:

if the item is not purchased using the store credit card account, notify the customer of potential credits if a balance is transferred from another credit card account to the store credit card account;

determine whether the customer has transferred a balance from another credit card account to the store credit card account; and

credit the amount to the store credit card account of the customer if the customer has transferred a balance from another credit card account to the store credit card account.

30. (Previously Presented)   The computer readable medium of claim 13, wherein the operations further comprise:

if the item is not purchased using the store credit card account, notify the customer of potential credits if a balance is transferred from another credit card account to the store credit card account;

determine whether the customer has transferred a balance from another credit card account to the store credit card account; and

credit the amount to the store credit card account of the customer if the customer has transferred a balance from another credit card account to the store credit card account.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.